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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,659	02/21/2002	Suresh K. Marisetty	42390P2319RC	4488

7590 09/23/2003

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EXAMINER

AUVE, GLENN ALLEN

ART UNIT	PAPER NUMBER
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2181

DATE MAILED: 09/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,659

Applicant(s)

MARISSETTY, SURESH K.

Examiner

Glenn A. Auve

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION***Reissue Applications***

1. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The supplemental declaration filed March 4, 2003, fails to identify a *specific* error relied upon to support the reissue. 37 CFR 1.175 and MPEP §1414 require the identification of a specific error. The general statement that the claims are too narrow because the attorney failed to appreciate the full scope of the invention does not specifically identify a word, phrase, or expression in the specification or an original claim that renders the original claim wholly or partially inoperative. Particular attention is directed to MPEP page 1400-23 which is §1414(II) which states in pertinent part:

The "at least one error" which is relied upon to support the reissue application must be set forth in the oath/declaration. It is not necessary, however, to point out how (or when) the error arose or occurred. Further, it is not necessary to point out how (or when) the error was discovered. If an applicant chooses to point out these matters, the statements directed to these matters will not be reviewed by the examiner, and the applicant should be so informed in the next Office action. All that is needed for the oath/declaration statement as to error is the identification of "at least one error" relied upon.

In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid. The corresponding corrective action which has been taken to correct the original patent need not be identified in the oath/declaration. If the initial reissue oath/declaration "states at least one error" in the original patent, and, in addition, recites the specific corrective action taken in the reissue application, the oath/declaration would be considered acceptable, even though the corrective action statement is not required.

It is not sufficient for an oath/declaration to merely state "this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure." **Rather, the oath/declaration must specifically identify an error.** In addition, it is not sufficient to merely reproduce the claims with brackets and underlining and state that such will identify the error. See *In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), cert. denied, 484 U.S. 894 (1987). **Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error.**

[emphasis added]

2. Claims 36-90 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

3. Claims 36-90 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

As was noted in the previous action and in the parent case, the claims in this reissue application are broadened in a way that has resulted in an impermissible recapture of subject matter surrendered in the parent patent.

When determining whether recapture exists various test have been devised by the courts. The facts in Pannu and Clement appear to be most relevant to the facts in the present case. Those courts developed what are basically three part tests for determining whether or not recapture exists. First, did applicant broaden the claims; secondly, if so, is the broadening

related to what was surrendered during prosecution of the patent; and third, have the claims also been materially narrowed.

The original or "surrendered" claim recites the use of a device driver for controlling power to various devices. The newly presented reissue claims do not include limitations drawn to the device driver or the virtual device driver limitation which was added in the amendment in order to make the patent claims allowable. Applicant freely added the "virtual" limitation to the claim and also argued it as the reason for allowability over the prior art. Even if only the original claim is what has been "surrendered", the claims in the reissue broaden even beyond that claim with respect to the fact that the reissue claims now only recite a power management module or program instructions for managing power consumption, and the device driver limitations are not present. Therefore, the claims are broader in that respect. So, with regard to the first part of the test, applicant's independent claims are broader than claim 11.

Next, it is necessary to determine whether the broader aspect of the reissue claim is related to the surrendered subject matter. Applicant's original claim was rejected over the prior art to Smith and Stewart which showed a system with device drivers monitoring devices and controlling power to them. This rejection was overcome by adding the "virtual device driver limitation" to the claims. Therefore, the broadening removal of the device driver and virtual device driver limitations do broaden the claims in an aspect related to what was surrendered. The question then becomes whether or not the addition of power management module or instructions which control power to configurable devices is a material narrowing which avoids recapture.

It is submitted that the presence of the power management module or instruction limitations that measure the amount of time the processor has its clock stopped and reduce the voltage level applied to a processor as a result of the measuring in the reissue claims are not a

material narrowing of the surrendered subject matter with respect to the prior art rejection. The rejection was related to the use of a device driver for controlling power to devices. The reissue claims are broader in that respect as noted above. The fact that other limitations have been added that are not related to either the use of a device driver or virtual driver, that is to say, the addition of the limitation that the processor has its voltage reduced in response to the amount of time it has its clock stopped, is not a material narrowing germane to the prior art rejection.

Clement dealt with a similar issue in that the claims had been broadened with respect to the surrendered subject matter but had other narrowing limitations added. There the court found that recapture did exist because on balance the claims were broader than they were narrower in a manner directly related to the subject matter surrendered throughout prosecution. Clement at 1167. The same sort of situation exists in the present case.

Similarly, the facts in Pannu also seem to mirror those in the present case. In the present case the addition of the time determining and voltage reducing limitations are not necessarily related to the use of a device driver for controlling power. In Pannu the court found that, "The narrowing aspect of the claim on reissue, however, was not related to the shape of the haptics, but rather to the positioning and dimensions of the snag resistant means." That court decided that this fact meant that, "The reissued claims were not narrowed in any material respect compared with their broadening." Such a statement also applies to reissue claims in the present case in that any narrowing is with respect to the time determining and processor voltage reducing, not to the driver doing the controlling. Therefore, it is believed that impermissible recapture exists with respect to the claims.

R sponds to Arguments

4. Applicant's arguments filed August 27, 2003, have been fully considered but they are not persuasive. With respect to the defective declaration, applicant argues that it is enough to merely say that applicant's attorney failed to appreciate the full scope of the invention and that this is the error relied upon for the filing of the reissue. However, as noted above applicant must also in addition to such a statement set forth at least one specific limitation related to the alleged overly narrow nature of the patented claims. Applicant has pointed to small portions of MPEP §§ 1414 and 1402 somewhat out of context in order to attempt to overcome this rejection. A more complete copy of §1414(II) has been cited above with the most pertinent portions highlighted.

Applicant also argues that the recent Board decision in Ex parte Eggert indicates that it is not proper to preclude applicant's claims under the recapture doctrine "merely because they do not relate to a limitation allegedly relied upon for patentability in the original application" (page 5 of the August 27, 2003, response). However, what Eggert really seems to be saying is that there is no per se rule barring claims that eliminate limitations relied upon for patentability, but that the three part test introduced by the Federal Circuit in Clement and reiterated in Pannu must be applied to the specific fact situation in each case. The examiner has applied the three part test as outlined by the Federal Circuit to the claims in the present application as noted above in the recapture rejection. The examiner has not applied a per se rule with regard to the elimination of the limitations added to overcome the prior art in the parent case having been omitted in this application, which Eggert seems to say is improper. The Board in Eggert appears to be reiterating the three part test set forth by the Federal Circuit. The Board also appears to be saying that a broader version of the same narrowing limitation which was relied on to establish patentability may not give rise to a recapture rejection. Applicant appears to believe that the fact that the claims have had allegedly narrowing limitations added to them somehow allows them to

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avoid the recapture rule altogether. In fact the Board in Eggert (at page 34) states with respect to the decision in Pannu:

"We understand this language, consistent with the prior precedent of the Federal Circuit, to mean that, where a patentee is seeking to recover in a reissue claim subject matter broader than that surrendered during prosecution, the mere presence of narrowing limitations in the reissue claim is not necessarily sufficient to save the reissue claim from the recapture rule. In other words, the Federal circuit rejected a per se rule that any narrowing limitation in a reissue claim that has also been broadened in an aspect related to surrendered subject matter escapes the effect of the recapture rule."

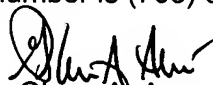
The Board and the Federal Circuit seem support the examiner's position that the alleged narrowing limitations do not necessarily allow applicant to avoid the recapture rule when such limitations are not related to the surrendered subject matter.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn A. Auve whose telephone number is (703) 305-9638. The examiner can normally be reached on M-Th 8:00 AM-5:30 PM, every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (703) 305-4815. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Glenn A. Auve
Primary Examiner
Art Unit 2181

gaa
September 17, 2003